



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,662	12/29/1999	WILLIAM M. RISEN JR.	RISEN-01	1274

7590

10/09/2002

DIANE F COVELLO
125 WALBRIDGE RD
W HARTFORD, CT 06119

EXAMINER

ROSEN, NICHOLAS D

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/473,662

Applicant(s)

RISEN ET AL.

Examiner

Nicholas D. Rosen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,13-15,17,19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,13-15,17,19,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 7.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3625

Claims 1-11, 13-15, 17, 19, 21, and 22 have been examined.

Drawings

The drawings submitted July 17, 2002, have been approved by the examiner and by the draftsperson.

Specification

The disclosure is objected to because of the following informalities: On page 15, line 22, reference is made to "the method described in claim 6 of this patent." This reference does not appear to refer to the current claim 6, but presumably to the claims originally filed in the parent case.

Appropriate correction is required.

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with attorney Diane F. Covello on September 27, 2002.

The application has been amended as follows: In claim 1, line 4, replace "party" by -- party; --. In claim 1, line 5, replace "asset," by -- asset; --. In claim 1, line 7,

Art Unit: 3625

replace "asset," by – asset; --. In claim 22, line 4, replace "party," by – party; --. In claim 22, line 6, replace "right," by – right; --. (That is, replace commas by semicolons as indicated.)

Claims 25 and 26 are hereby cancelled.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11, 13-15, 17, 19, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract ideas, laws of nature, or natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter.

The process recited must somehow affect, effect, or be effected by technology. The claimed method of providing protection against an unexpected change in value of an intellectual property asset does none of these.

Moreover, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. The claimed method of providing

protection against an unexpected change in value of an intellectual property asset does not produce a concrete and tangible result.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract ideas, laws of nature, or natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter.

The process recited must somehow affect, effect, or be effected by technology. The claimed method of insuring against a risk of an unexpected reduction in value of a patent right does none of these.

Moreover, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. The claimed method of insuring against a risk of an unexpected reduction in value of a patent right does not produce a concrete and tangible result.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

Art Unit: 3625

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11, 13-15, 17, 19, and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites determining a value of at least one intellectual property asset, but the specification does not describe these steps in a sufficiently concrete manner as to enable one skilled in the art to which the application pertains to use the invention. As the specification teaches, "Assigning a value to a patent can be difficult" (page 15, line 14), and subsequent passages fail to set forth how it is to be done. It is suggested, for example, that, "One preferred method of assigning such a value is to retain a firm which specializes in the valuation of intellectual property," but that is not transparent; it does not teach how such a firm obtains the values it does. The specification also suggests using the method of patent 5,608,620, but the '620 patent only discloses a method of giving forecasters an incentive to make reliable forecasts; it does not specify how they are to make forecasts, or in particular, how they are to value intellectual property assets.

Claims 2-11, 13, 15-17, 19, and 21 are rejected as depending on claim 1.

Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 22 recites assigning a value to a patent right and

Art Unit: 3625

estimating the likelihood of an unexpected reduction in value of the patent right, but the specification does not describe these steps in a sufficiently concrete manner as to enable one skilled in the art to which the application pertains to use the invention. As the specification teaches, "Assigning a value to a patent can be difficult" (page 15, line 14), and subsequent passages fail to set forth how it is to be done. It is suggested, for example, that, "One preferred method of assigning such a value is to retain a firm which specializes in the valuation of intellectual property," but that is not transparent; it does not teach how such a firm obtains the values it does. The specification also suggests using the method of patent 5,608,620, but the '620 patent only discloses a method of giving forecasters an incentive to make reliable forecasts; it does not specify how they are to make forecasts, or in particular, how they are to value patent rights or estimate the likelihood of an unexpected reduction in value of the patent right.

It may further be observed that estimating the likelihood of an unexpected reduction in value of a patent right appears to be a difficult and paradoxical task; for the reduction to be unexpected, it must be based on possible future events that are not widely predicted or easily foreseen, or else perhaps on possible future events whose impact on the value of a patent is not obvious.

Response to Arguments

Applicant's arguments with respect to claims 1-11, 13-15, 17, 19, 21, and 22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Because of the rejection of the claims on grounds not applied before, this rejection is non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and for After Final communications. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Nicholas D. Rosen
Nicholas D. Rosen
October 1, 2002